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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,819	06/25/2001	Robin S. Gray		9738

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EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,819

Applicant(s)

GRAY, ROBIN S.

Examiner

Ming-Hun Liu

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendments concerning the claims, drawings and specifications have been acknowledged and will be entered.

Claim Objections

2. Claim 27 are objected to because it is identical to claim 26. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5-7, 10, 12, 22, 24-29, 33 and 34 are rejected under 35 U.S.C. 102(e) as being unpatentable by US Patent 6,359,611 to Chan.

In reference to claims 1 and 2, it can be seen from figure 1 that Chan teaches a mouse system with at least one mechanical press mouse button (figure 1, items 125, 120 and 130) where there is a touch pad (item 155) that is physically integrated into the cavity of that button (125).

In reference to claim 5, it is clearly explained that item 155, is a finger controlled depression (column 5, 26-29).

In reference to claims 6 and 7, Chan clearly demonstrates that in his mouse there are two motions positioning motions, one the rough sweeping motion of the commonly known mouse, the other the precision finger movement direction described in column 5, line 55-60.

In reference to Claim 10, it is shown in the figures that the touch pad is integrated into a cavity of the mechanical mouse button.

In reference to claims 12 and 22, it is obviously shown in Chan's figures that the mouse is an auxiliary computer mouse.

In reference to claims 24, 26-28 it is apparent from the description offered in column 5, lines 44-60 that the user does not need to raise the hand or reposition to move the cursor with the fine finger movements and that the coarse and fine movements are disjoint functions.

In reference to claims 25, 33 and 34, it can be seen from Chan's figures that the housing cavity and touch pad coincide in position during physical manipulation (column 5, lines 21-29). Furthermore, during contact the touch pad extends into the cavity.

In reference to claim 29, there is no disclosed criticality as to why the touch pad must be on a backlit area. Backlighting input devices is an aesthetic design component that is regularly implement and commonly known in the mouse art. One skilled in the art could have easily implemented a backlight by adding a simple LED to the circuitry. It would have been obvious to add a light because of the extreme conventionality of the practice that increases aesthetic value and also acts as location cue in the dark.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Howard et al.

In reference to claims 3, 4, 8 and 9, there is no disclosed criticality as to why a press and lock button or a slide panel button must be used in the claimed invention.

Nowhere in the specification does the applicant explicitly outline the unique advantages of implementing these particular button types.

As shown in Howard, different buttons on mice have been known in the art for a while. The buttons claimed are commonly used types of buttons in the art and is a design alternative that can be easily substituted and replaced by the engineer.

7. Claims 11, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan and US patent 5,530,455 to Gillick et al.

In reference to claims 11, 30 and 31, Chan teaches an auxiliary mouse with a mechanical button that is similar to the one being claimed.

However, Chan does not go as far as to include a side button/touch pad t the sidewall of the mouse. Gillick on the other hand, does teach the addition of a side button.

One skilled in the art understands that additional buttons can be added to the mouse in various positions that seem most natural to a hand's grip. Placing a button/touch pad at the side of a mouse is an addition that does not change the complex circuitry, but rather just the physical position of an element.

It would have been obvious to one skilled in the art to include an additional button on the side of the mouse, because that is the position where the thumb naturally rests and allows for an additional command method.

8. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of US patent 5,936,555 to Zagnoev.

In reference to claims 13 and 14, Chan teaches a mouse system with a mechanical button that is similar to the one being claimed. However Chan does not teach the incorporation of the mouse onto a computer keyboard.

Zagnoev's invention demonstrates the well-known combination of a mouse embedded onto a keyboard.

A mouse can be easily integrated into a keyboard, simply by combining the circuitry and housing of the two disjoint components.

It would have been obvious to one skilled in art to add a mouse onto a keyboard because of its extreme conventionality and the added value of space-saving and convenience factors.

Claims 15 and 16 are rejected with the same reasoning presented in the rejection of claims 3 and 4.

Claim 17 is rejected with the same reasoning presented in the rejection of claim 10.

9. Claims 18-21, 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of US Patent 5,473,347 to Collas et al.

In reference to claims 18-21, 23 and 32, Chan teaches a mouse system that resembles the claimed invention however he does not incorporate his invention onto the sidewall of a keyboard.

Much like the reasoning offered in the rejection of claim 11, placing mouse buttons on the sidewall of a computer keyboard is also very customary in the art.

As Collas describes in the abstract of his invention, mouse buttons can be placed on the side of the keyboard for simpler, no natural feel for the user.

As for claims 18-20 and 32, it must be noted that even though Collas' invention deals primarily to laptop keyboards, one skilled in the art understands that an improvement on a laptop keyboard is easily translated to a stand-alone desktop computer keyboard.

Response to Arguments

10. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

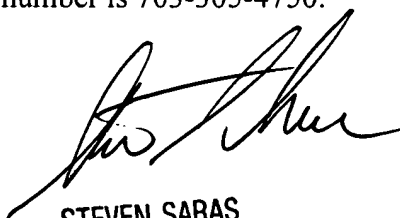
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Ming-Hun Liu



STEVEN SARAS
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